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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/872,976	05/31/2001	Paul Joseph Datta	659/829	3040

7590 03/27/2002

BRINKS HOFER GILSON & LIONE  
P.O. BOX 10395  
CHICAGO, IL 60610

EXAMINER

REICHLER, KARIN M

ART UNIT

PAPER NUMBER

3761

DATE MAILED: 03/27/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/872976

Applicant(s)

Datta et al

Examiner

Rerehip

Group Art Unit

3761

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☒ Responsive to communication(s) filed on 5-31-01
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-14 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1-14 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☒ The drawing(s) filed on 5-31-01 is/are objected to by the Examiner.
- ☒ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
- ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other \_\_\_\_\_

Office Action Summary

### DETAILED ACTION

1. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

For Example:

2. On page 1, lines 5-7 Applicants claim the benefit of priority (in the declaration under 35 USC 120) of two copending applications with different inventive entities but at least one common coinventor. The relationship, i.e. continuation, CIP or division, is lacking. What is the relationship?

3. The abstract of the disclosure is objected to because on line 5, "was" should be -- has --. Correction is required. See MPEP § 608.01(b).

4. The drawings are objected to because in Figure 1A, the top layer of the chassis designated 15 and 12 and the absorbent pad is not designated 12. Element 5 in Figures 1B and Figure 2 are not consistent. Element 1 shown in Figures 1A and 1B and that in Figure 3 are inconsistent. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

5. The use of the trademark Kraton ® (pages 8, 12), CELGARD TM (pages 15 -16), Telfon TM (page 19), S/P TM-Certified Blood Saline (page 20), ESPO<sup>IR</sup><sub>1</sub>® N-TAF-CT (page 23), LYCRA ® (pages 25-27) Velcro ® (page 28) has been noted in this

application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

6. 35 U.S.C. 112, first paragraph, requires the specification to be written in "full, clear, concise, and exact terms." The specification is replete with terms which are not clear, concise and exact. The specification should be revised carefully in order to comply with 35 U.S.C. 112, first paragraph. Examples of some unclear, inexact or verbose terms used in the specification are: Page 5, line 28.

7. The disclosure is objected to because of the following informalities: 1) The Summary of the Invention Section, i.e. a description of the claimed invention, and the invention as claimed, i.e. claims 1-8 and 10-14, are not consistent in scope, see MPEP 608.01 (d) and 1302.01 2) The numeral 1 is used to denote different structure in Figures 1A, B and Figure 3. 3) Page 2, lines 2-3 and 8-10 and claims 4-5 and 7-8 which don't set forth an upper limit of about 1, 500g or about 250g, and page 3, lines 27-30 which set forth upper limits are inconsistent, i.e. what is the upper limit? 4) On page 2, last line "113" should be --1B --. 5) On page 4, line 11, "width" should be -- widths --. 6) On page 4, line 5, what are the "3" elastic panels? 7) On page 10, lines 26 et seq what is the application or patent number? 8) Is "Blue M Power O Matic" (page 16) a trademark? 9) The incorporations by reference should be checked for propriety, i.e. no

essential material incorporated by reference to foreign patents or applications or U.S. Patents or applications which themselves incorporate such material.

Appropriate correction is required.

8. Claims 1-8 and 10-14 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Where is there support both in this application and the parent application for refastenable discrete side panels having substantially the same length and width? Lines 5-6 of claim 6? Lines 5-6 of claim 1? Lines 4-5 of claim 3?

9. The amendment filed May 31, 2001 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the new Figures 1C-1D and the specification at page 3, line 9 – page 29, line 12 which were not set forth in the parent application, i.e. this “continuation” application is not a copy of the parent application.

Applicant is required to cancel the new matter in the reply to this Office Action.

10. Claims 1-2, 6-14 are objected to because of the following informalities: in claim 1, line 2, “and” should be -- end and a -- and on line 4, after “front”, -- end -- should be inserted. On line 7, “,” should be deleted. In claim 2, “on elastic panel” should be --

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said at least one of the elastic panels --. In claim 6, line 6, after "chassis," -- and -- should be inserted. This also applies to similar language in claim 9. In claims 12 and 14, line 1, after "core," and -- should be inserted. On lines 4 and 5, resp., "and," should be -- and --. In claim 1, lines 2 and 3, claim 9, line 4 before "having," -- further -- should be inserted. In claim 10, line 4, "," should be deleted. Appropriate correction is required.

11. Claims 1-2 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1 line 4, which "front end" ? That of the pant or that of the chassis?

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

13. Claims 1-2 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Fahrenkrug et al.

See Figures and column 11, lines 11-16 and 19-34, i.e. chassis, 12, elastic panel, all or part of 34, elastic side panels, parts of 34. As shown in the Figures 34 is wide enough to encircle the device and fasten to itself. Since the structure of Fahrenkrug is identical to that claimed, the capabilities and functions of the claimed structure, i.e. claim 1, lines 6-7, claim 2, and claim 9, lines 4-6, are presumed inherent also in the like structure of Fahrenkrug et al. It is noted that

MPEP 2112.01.

the claims do not require folding, do not require fastenability of panels prior to disposal, etc.

14. Claims 1-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Swenson '068.

See Figures, especially 13 – 16, and page 3, lines 34-43, i.e. panel is left handed lined portion attached to tab 1. As disclosed, the panel is wide enough to encircle device and fasten to itself. Since the structure of the Swenson device is identical to that claimed, the capabilities and functions of the claimed structure are presumed inherent, see MPEP 2112.01. With regard to claim 3, line 3, "substantially the same" as interpreted in light of the Figures and specification is interpreted as more than 50% in the relaxed state (Note, to interpret it otherwise would have no support in the specification). See Figures again. The comments with regard to inherency and claim scope set forth in the previous rejection are repeated here.

15. Claims 10-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Sageser et al.

See interpretation of "substantially the same" discussed supra. See Figure 8, column 14, line 29 – column 16, line 3 and thereby Scripps '724, e.g. Figures, and Buell et al '092, e.g, column 44, lines 47-51. The remarks with regard to inherency and claim scope in the previous two rejections are repeated here.

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

18. Claims 4-5 and 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Swenson et al in view of Sosalla. Applicant claims the absorbency of the product. See Swenson, page 1, line 5 and page 7, lines 32-34 and see column 12, lines 29-31 and 51-55 of Sosalla. Therefore, to employ the absorbent capabilities as taught by Sosalla on the Swenson device would be obvious to one of ordinary skill in the art in view of the recognition that such feature would accomodate wearers ranging from infants through adults and the desirability of such by Swenson.

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karin Reichle whose telephone number is (703) 308-2617. The examiner can normally be reached on Monday - Thursday.

K. Reichle:bhw

March 6, 2002

K. M. Reichle  
Karin M. Reichle  
Patent Examiner

**Attachment for PTO-948 (Rev. 03/01, or earlier)**  
**6/18/01**

**The below text replaces the pre-printed text under the heading, "Information on How to Effect Drawing Changes," on the back of the PTO-948 (Rev. 03/01, or earlier) form.**

**INFORMATION ON HOW TO EFFECT DRAWING CHANGES**

**1. Correction of Informalities -- 37 CFR 1.85**

New corrected drawings must be filed with the changes incorporated therein. Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and centered within the top margin. If corrected drawings are required in a Notice of Allowability (PTOL-37), the new drawings **MUST** be filed within the **THREE MONTH** shortened statutory period set for reply in the Notice of Allowability. Extensions of time may **NOT** be obtained under the provisions of 37 CFR 1.136(a) or (b) for filing the corrected drawings after the mailing of a Notice of Allowability. The drawings should be filed as a separate paper with a transmittal letter addressed to the Official Draftsperson.

**2. Corrections other than Informalities Noted by Draftsperson on form PTO-948.**

All changes to the drawings, other than informalities noted by the Draftsperson, **MUST** be made in the same manner as above except that, normally, a highlighted (preferably red ink) sketch of the changes to be incorporated into the new drawings **MUST** be approved by the examiner before the application will be allowed. No changes will be permitted to be made other than correction of informalities, unless the examiner has approved the proposed changes.

**Timing of Corrections**

Applicant is required to submit the drawing corrections within the time period set in the attached Office communication. See 37 CFR 1.85(a).

Failure to take corrective action within the set period will result in **ABANDONMENT** of the application.